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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,810	03/24/2004	Michael Albanese	10555-6	4378
7590 03/31/2006				
William Squire, Esq. c/o Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olstein 5 Becker Farm Road Roseland, NJ 07068			EXAMINER DESAI, ANISH P	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/807,810

Applicant(s)

ALBANESE ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The applicant's arguments in response to the Office action dated 12/08/05 have been fully considered.

1. The requirement for election-restriction is maintained.
2. The art rejections are withdrawn in view of the present amendments and response (see pages 4-6 and 13-16 of 01/20/06 amendments). However, upon further consideration a new ground of rejection is made over Figluzzi (US 3,537,578) in view of Thomason (US 4,195,787).

### ***Election/Restrictions***

3. Applicant's arguments with respect to the election-restriction requirement in the reply filed on 01/20/06 are acknowledged. The arguments with respect to the restriction of Group I claims 1-16 and Group II claims 17-23 are not found persuasive for following reasons.

Applicant argues that claim 22 is not directed to an electrical tape as asserted by the examiner. The examiner does not understand the applicant's argument, as the argument is not related to the election restriction requirement. The examiner recognizes that the claim 22 does not recite "electrical tape", however it is the examiner's position that the adhesive tape as claim 22 can be used as an electrical tape because claim 22 and claim 17 essentially claim the same subject matter. Further the applicant argues that there is no basis exists for the conclusion by the examiner that the thin film sheet of claim 1 can be used as a decorative wrap whereas the tape of claims 17 and 22 cannot be used as a decorative wrap. The examiner respectfully disagrees. It is the

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examiner's position that the tape of claim 17 and 22 can not be used as a decorative wrap whereas the thin film can be used as a decorative wrap, because the tape would stick to the material to be wrapped and can leave a residue on the material upon removal of the tape, whereas the thin film as claimed in claim 1 would not leave any residue on the material as there is no adhesive on the thin film of claim 1. Additionally note that the thin film sheet of claim 1 can also be used as a tissue paper whereas the tape of claims 17 and 22 cannot be used as a tissue paper. Further the applicant argues that the claims must be mutually exclusive to support a restriction and the claims 1, 17 and 22 overlap in scope, thus claims 1, 17 and 22 cannot be restricted. The examiner respectfully disagrees. Note that the thin film sheet as claimed in claim 1 does not require an adhesive coating whereas claims 17 and 22 require an adhesive coating. Thus, the scope of claim 1 does not overlap with the scope of claims 17 and 22. Further applicant draws the examiner's attention to the claims 2,6, and 8 which limit the independent claim 1 (thin film sheet) by requiring an adhesive coating on the thin film sheet, thin film sheet in the form of tape, and an electrical tape respectively. The applicant then argues that the restriction is improper because claims 1, 17 and 22 are directed to a tape. The examiner respectfully disagrees. The examiner respectfully reminds the applicant that the election restriction requirement is made by comparing the broadest claims from each group to determine if the inventions are patentably distinct or not. The broadest claims being the independent claims 1, 17 and 22 in the presently claimed subject matter, thus the claim 1 does not require an adhesive coating whereas

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the claims 17 and 22 require an adhesive coating. Thus, the requirement for election restriction is deemed to be proper.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figluzzi (US 3,537,578) in view of Thomason (US 4,195,787).

Figluzzi teaches a pressure sensitive adhesive tape such as an insulating tape (Column 1, lines 7-10). Figure 3 of Figluzzi shows a spiral roll of a tape. The invention of Figluzzi relates to a new and improved means for marking a tape such that the location of the free end of the tape can be ascertained in order to remove the tape from a roll (Column 1, lines 1-6). Figure 3 of Figluzzi shows a spiral roll of a tape with overlying multiple layers and a free end 13 of the tape, which reads on the layers extending from a first interior roll to a second free end terminating at an edge on the outermost layer of the roll, the edge overlying the outer surface of the next adjacent radially inward layer as claimed in the presently claimed subject matter. Additionally the spiral roll of a tape as shown in the Figure 3 of Figluzzi reads on a spiral roll of the material having opposing ends as claimed in the presently claimed subject matter. Moreover, Figluzzi teaches that the markings 12 on the tape extends diagonally from one corner of the tape at the end thereof down to the other end thereof at the outer

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corner of the tape (Column 1, lines 44-47). Further, Figures 1, 2 and 4 along with the claim 4 of Figluzzi disclose a printed pattern on the tape, which is substantially continuous as claimed in claim 18. Further, as shown in the Figure 1, the sheet of the tape of Figluzzi seems to have a uniform color or a first color as claimed in claims 17 and 22 respectively and it is different from the color of the pattern 12 and 12a.

Alternatively, the color of the pattern would have to be of a different color than the uniform color of the sheet onto which the pattern is formed in order for the pattern to be clearly visible on the tape. Regarding claim 19, although Figluzzi does not explicitly teach dashed or dotted lines, however Figluzzi broadly teaches a pattern in the form of a line (Figure 1) on a tape such that the free end of the tape can be easily identified. Thus, in the absence of unexpected results, a skilled artisan can obviously choose the pattern of dashed or dotted lines on the tape of Figluzzi, motivated by the desire to easily identify the free end of the tape. With respect to claim 20, Figure 2 and claim 4 of Figluzzi read on the claimed limitation of the pattern at the edge is discontinuous with the pattern on the juxtaposed surface of the next adjacent radially inward layer. With respect to claim 21, Figures 1, 2, and 4 of Figluzzi show pattern of a line, a curved line, and a sinusoidal curve.

Figluzzi is silent as to teaching of a pattern comprising two spaced apart lines or plurality of side-by-side lines. However, Thomason teaches rolled products (Column 1, lines 25-26) such as tissue paper, friction tape, electrical tape etc. (Column 1, lines 7-10). The invention of Thomason provides marking arrangements, which permits easy access to the beginning or the front part of the rolled product (Column 1, lines 11-13).

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In Figures 1-7, especially Figures 1-4, Thomason show decorative lines (also called by marking or pattern by Thomason) (Column 1, line 19). Further, Figures 1 and 2 of Thomason seem to show plurality of lines that are side by side or in a spaced apart relationship. Thus, a skilled artisan would have found it obvious to use at least two spaced apart lines or plurality of side by side lines in the invention of Figlluzzi, motivated by the desire to enhance the aesthetics and to easily locate the free end of the tape of Figlluzzi.

With respect to claim 23 although Figlluzzi as modified by Thomason is silent as to teaching of colors of the lines are the same, each second color is one of green, white, and red. Note that Figlluzzi and Thomason are concerned with the same problem, namely to provide a roll of a tape with a pattern such that the free end of the tape is easily visible to a user. Therefore, it is the examiner's position that the choice of a color involves routine skill in the art and thus is not a patentable over the prior art. Therefore, a skilled artisan would have found it obvious to select the color of the pattern comprising lines of Figlluzzi as modified by Thomason from any of green, white and red, motivated by the desire to provide a tape with a pattern such that the free end of the tape is clearly visible.

### ***Response to Arguments***

Applicant's arguments with respect to claims 17-23 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD



**HAI VO**  
**PRIMARY EXAMINER**